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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/357,836	07/21/1999	LISA T. WOOD	032374-003	9787

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EXAMINER

HAILU, TADESSE

ART UNIT PAPER NUMBER

2173

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/357,836

Applicant(s)

Lisa T. Wood, et al.

Examiner

Tadesse Hailu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 27, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8-10, 13, and 15-47 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8-10, 13, and 15-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

BA HUYNH
PRIMARY EXAMINER

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DETAILED ACTION

1. This Office Action is in response to an Amendment entered 9/27/2002 for the patent application (09/357,836) filed on 07/21/1999.

Status of the claims

2. Claims 2-6, 8-10, 13, 15-47 are pending.

Claim Rejections - 35 USC § 112

3. Claims 2-6, 8-10, 13, 15, 25-30, 42-44, 34, 36-38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither "the media object identifier embedded within a third-party web site," "third party web site" nor "embedding in the web site" is disclosed.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 25-30, 31-35, 42-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter "Software". A software or control program *per se* does not fit any of the four statutory classes of invention. The invention itself is nothing

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more than a collection of programming code. Thus, the invention fails the test for whether it is a specific "machine, process or article of manufacture"

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. **Claims 2, 5, 6, 8-10, 13, 15, 17, 20-47 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,035,323 to Narayen et al.**

The present invention is directed to a transportation and Internet publishing of digital content, particularly, image media objects and rich media. Similarly, Narayen et al (hereinafter "Narayen") is directed to the same invention, i.e. Narayen directed to a publishing digital images over a network operating according to Internet or intranet protocols. Consequently, after thorough analyzing, the examiner believes that the present invention is claiming the teachings of Narayen. Thus, the present claimed invention is rejected by Narayen.

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Regarding claim 15, to begin with, examiner believes that the claimed "media object identifier" (or "ImageWell") is equivalent to "media container" as discussed in Narayen. Thus, this "media container" includes a graphical user interface where user can manipulate (edit) album images (col 7, lines 49-col 8, lines 6, col 9, lines 21-64). A user of a computer system then may create a picture album or another type of media container using a media authoring program of the invention. The client software program (media authoring program) which includes the media container could be available by interacting with the server or alternatively the client software program can be integrated or configured at the client system ("third party") without any specialized server software (col 16, lines 15-30). This configuration enables the client software to automatically generate publishable web pages (col 16, lines 15-30). The user of the client computer system can cause a media container with its associated digital media to be published to the Internet for others to view with conventional web browsers, such as Netscape's Navigator or Microsoft's Internet Explorer. Narayen further describes that any unrestricted member of the public has the capability to publish such media containers with the associated digital media (col 7, lines 49-col 8, lines 6). The web-viewable format images are pre-generated prior to "publication" or distribution to other client computer systems (col 11, lines 1-49).

Regarding claim 16, In addition what is claimed in claim 15, this claim recites the further limitation of pre-processing the media object. Narayen further describes similar limitation, i.e., the album authoring software scales (adjusting the size) each picture if necessary to cause it to fit into the corresponding slot (predetermined size) on the album page. The user

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may at any time change the layout or style and the album will automatically and dynamically reformat itself (col 8, lines 60-col 9, lines 64).

Regarding claims 25 and 31, The language contained within claims 25 and 31 generally parallels claim 1, therefore the analysis applied to the above claim applies to these claims.

Regarding claims 2, 17, 26 and 32, Narayen further discloses pre-processing including, among others, changing the aspect ratio (col 9, lines 21-64), allowing a user to enter caption or title, Chang file size, number of pixel, changing format (col 13, lines 15-42, col 14, lines 22-34).

Regarding claims 5 and 20, Narayen further describes plurality of pictures can be associated or placed to an album (col 9, lines 20-64).

Regarding claims 6, 21, 27 and 33, Narayen describes the selected plurality media (such as pictures) could be associated to a more than one media container that is generated automatically (col 7, lines 14-48, col 9, lines 21-64).

Regarding claims 8 and 28, Narayen further discloses reducing or scaling to fit the slot in the album (col 9, lines 21-64, col 13, lines 15-42).

Regarding claims 9 and 29, Narayen further discloses reformatting the media (col 13, lines 15-42).

Regarding claims 10 and 22, Narayen further discloses the media container allows display of the media in web page format (col 11, lines 7-61).

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Regarding claims 13, 24, 30 and 35, Narayen further discloses that the term digital media includes digital images, such as digital pictures imported or acquired from a digital camera as well as audio files and video files (e.g. Quicktime files) and other digital documents such as word processing files (col 7, lines 2-13).

Regarding claims 23 and 34, Narayen further discloses that the client software program (media authoring program) which includes the media container is integrating in the he client web site (col 16, lines 15-30).

Regarding claims 36, 39, 42 and 45, Narayen further discloses the media container also controls the operations prior to publishing the album on the web (col 8, lines 7-59).

Regarding claims 37, 40, 43 and 46, as described above in claim 15, the client software program which includes the media container can be integrated or configured at the client system ("third party") without any specialized server software (col 16, lines 15-30). This configuration enables the client software to control the web page generation from start to finish.

Regarding claims 38, 41, 44 and 47, as described above in claim 15, the client software program does require a web site for preprocessing and uploading and the media to be published (col 16, lines 15-30).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 4, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,035,323 to Narayan et al in view of Admission of prior art.

Narayan describes selecting pictures in order to place or associate with the album (media container). Since Narayan is a GUI system, Narayan could have used drag and drop for selection, but whether the selection made via drag and drop or browsing and selecting is not explicitly described. However, dragging or selecting by browsing are conventional as described in the Admitted prior art (page 2, lines 10-22). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the present invention was made to incorporate the conventional drag and drop or selecting by browsing mechanism to select and place or associate the pictures with the album (media container).

Conclusion

10. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R § 1.111© to consider these reference fully when responding to this action. The documents cited therein, Boezeman et al (6,012,068) relates to methods of operating a computer systems attached to a network, such that the computer system can access data and code over the network. Boezeman further describes about a third party server system (Fig. 2, col 4, lines 45-55).

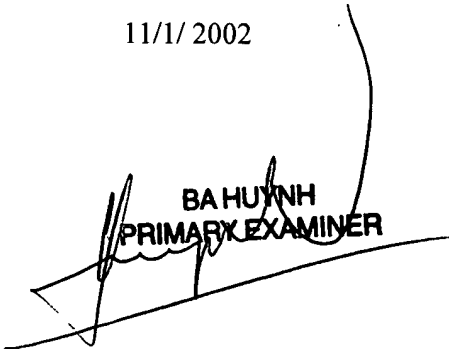
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11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Tadesse Hailu*, whose telephone number is (703) 306-2799. The Examiner can normally be reached on M-F from 10:00 - 8:30 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, *John Cabeca*, can be reached at (703) 308-3116 Art Unit 2173 CPK 2-4A51.

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu

11/1/ 2002


BA HUYNH
PRIMARY EXAMINER